

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): LATTER ET AL.
Appl. No.: 09/122,484
Conf. No.: 4450
Filed: JULY 24, 1998
Title: METHOD AND SYSTEM FOR PROVIDING
ENHANCED CALLER IDENTIFICATION
Art Unit: 2614
Examiner: TRAN, QUOC DUC
Docket No.: 08285-00181

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed
March 19, 2007.

REMARKS

Appellant submits and maintains that the rejections based on the combination of U.S. Patent No. 5,497,414 to Bartholomew ("*Bartholomew*") in view of U.S. Patent No. 5,905,774 to Tatchell et al. ("*Tatchell*") fail to establish a *prima facie* case of obviousness¹ and should be withdrawn. In particular, the relied upon references, either alone or in combination, do not teach or suggest all of the limitations or elements recited, and do not provide the necessary suggestion or motivation to make the relied upon combination.

As previously discussed in Appellant's Appeal Brief dated December 15, 2006, independent claims 57, 60, 68, 69, 70, 71, 77, 84 and 91 to 93 recite generally methods and systems for processing a call from a calling party at a calling communication station to a called communication station that include, in relevant part, determining whether standard caller identification information for the calling communication station can be provided to the called communication station; transmitting a request for audible caller identification information to the calling communication station in response to a determination that the standard caller identification information cannot be provided to the called communication station; and connecting the calling communication station and the called communication station without providing any caller identification information to the called communication station. (See figures 2, 5; page 3, lines 8-11; page 6, lines 12-18). In other words, when caller identification information is not provided to the called communication station, the called communication station contacts the calling communication station and the calling party and requests *audible* caller identification be provided. The call may then be connected to the called communication station without provided the requested and received audible caller identification.

¹ To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (b) Second, there must be a reasonable expectation of success.
- (c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

Bartholomew does not disclose transmitting a request for audible caller identification as admitted in the final Office Action dated February 17, 2006 (*see* page 3, paragraph 3) and Examiner's Answer dated March 19, 2007 (*see* page 4, paragraph 1). *Bartholomew* simply discloses utilizing a personal identification number (PIN) to control caller access and routing without obtaining standard caller identification information from the calling party and without providing caller identification information to the called party.

Contrary to the characterization replied upon in the final Office Action and Examiner's Answer, *Tatchell* does not disclose or provide the teaching missing from *Bartholomew*. *Tatchell* simply discloses a Personal Agent or agent that, among other things, operates and administers a call screening and prioritization list that identifies and verifies incoming calls when the subscriber is on-hook. For example, as described at col. 20, line 39 to col. 21, line 20 of *Tatchell*, all calls by a calling party to a directory number of a called party invoke the agent which, in turn, determines the presence or absence of call identification information. Upon determination that caller identification information is not provided, "the agent answers the call and asks for name and number", (*see* col. 20, lines 50 to 52 and FIG. 8b at block 90). The provided information is then used by the agent to determine "if it is specified by the subscriber [of the service] in the call screening and prioritization list," (*see* col. 20, lines 52 to 54). In other words, the provided name and number are utilized by the agent to connect or invoked the call screening and prioritization list **and not to connect to the called communication station**. Stated another way, the system of *Tatchell* utilizes caller identification information, regardless of how it is provided or obtained, to control access to the call screening and prioritization list. It is the options or configuration of the call screening and prioritization list which, in turn, determines whether the incoming call is to be connected with the called communication station.

Moreover, even if, caller identification information was utilized to connect the incoming call and not to simply access the call screening and prioritization list, *Tatchell* explicit discloses providing a name announcement based on the caller identification information to the called communication station (*see* col. 21, lines 31 to 36). This disclosure directly contradicts the systems and methods recited in the claims.

For at least these reasons, it is clear that the combination of *Bartholomew* and *Tatchell* does not disclose each and every element set forth in claims and/or provide

the suggest, motivation or even a reason to combine these distinctly different systems and methods. For example, *Bartholomew* discloses prompting a caller for PIN to complete a call, while *Tatchell* discloses asking for the calling party's name and number to access a call screening and prioritization list and providing the name and number to the called party. Appellant submits that the relied upon combination would not provide the claimed system and method because replacement of the PIN prompt of *Bartholomew* with the teaching of *Tatchell* would result in a system in which the name and number, e.g., the caller identification information, was provided to the called communication station. Thus, Appellant maintains that the combination of *Bartholomew* and *Tatchell* cannot be a basis for establishing a *prima facie* case of obviousness. Thus claims 57 to 66 and 68 to 93 are not rendered obvious over either of the cited references or the combination there, and the rejections should be withdrawn.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

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